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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,205	01/20/2006	Uri Arnin	1454VASUS	9521

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7590 06/05/2009

EXAMINER

SCHILLINGER, ANN M

ART UNIT	PAPER NUMBER
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3774

MAIL DATE	DELIVERY MODE
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06/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,205	Applicant(s) ARNIN ET AL.	
	Examiner ANN SCHILLINGER	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 8-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Globerman et al. (U.S. Pat. No. 7,097,648) in view of Foley et al. (US Pat. No. 6,676,665). Globerman et al. discloses the following of the claimed invention: a sheath (20; col. 10, lines 19-26) having a first non-expanded position (Figure 1A) and a second expanded position (Figures 1C, 1D), and surrounding an outside portion of a rod (60); a sheath compactor (102); a stopper (408); a guiding wire (100); and a second stopper (106). The device may be constructed from shape memory and/or elastomeric material, which may form an arcuate shape (col. 10, lines 19-26) and would be capable of expanding in a uniform or a non-uniform manner. As the sheath is being expanded, it will have a varying distance between the folds, and more folds on one side than the other.

Globerman et al. does not teach the sheath being made of an elastomeric material. Foley et al. teaches a surgical instrumentation system for use in the spine, whose sheath (32) is formed of elastomer (col. 4, lines 27-54) for the purpose of providing the sheath with flexible properties. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the elastomeric material of Foley et al. to construct the flexible sheath of Globerman et al. in order to provide the sheath with flexibility.

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Please note that the claim language “adapted to/for” and “configured to/for” is functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

In re Fuller, 1929 C.D. 172; 388 O.G. 279.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Globerman et al. in view of Brumfield et al. (U.S. Pat. No. 6,235,028). Globerman et al. discloses the claimed invention except for constructing the rod from a shape-memory material. Brumfield et al. teaches a spinal prosthesis that uses a guide, insertion rod which is made of a shape-memory material in col. 12, lines 30-57 for the purpose of allowing the rod greater flexibility, while still maintaining its original shape. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the rod of Brumfield et al. from a shape-memory material in order to give the rod greater flexibility, while still maintaining its original shape.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Globerman et al. in view of McNamara et al. (U.S. Pat. No. 5,147,370). Globerman et al. discloses the claimed invention except for the use of a fastening ring. McNamara et al. teaches a biological prosthesis that uses a fastening ring in column 9 for the purpose of securely connecting parts of the device

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together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a fastening ring in order to securely connect parts of the device together.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Globerman et al. in view of Reiley et al. (U.S. Pat. No. 6,248,110). Globerman et al. discloses the invention substantially as claimed, however, Globerman does not teach the rod having a removable portion. Reiley et al. teaches a biological prosthesis that uses a rod with a removable portion in col. 8, lines 52-60 for the purpose of allowing easier use and manipulation of the rod. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rod of Globerman et al. by making a portion of it removable in order to allow easier use and manipulation of the rod.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Globerman et al. in view of Scholten et al. (U.S. Pat. No. 4,969,888). Globerman et al. discloses the claimed invention except for the use of an anchor. Scholten et al. teaches a vertebral prosthesis that uses an anchor in col. 4, lines 55-68 for the purpose of keeping the inserted device in its desired location. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an anchor in order to keep the inserted device in its desired location.

Claim Objections

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

Applicant's arguments, see the response, filed 4/7/2009, with respect to the rejection(s) of claim(s) 1-19 under *Globerman et al.* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made over *Globerman et al.* in view of *Foley et al.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./

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Examiner, Art Unit 3774

/DAVID ISABELLA/

Supervisory Patent Examiner, Art Unit 3774